

REMARKS

Applicants have carefully reviewed the Final Office Action mailed April 27, 2009 and offer the following remarks to accompany the above amendments.

Status of the Claims

Claims 39-47, 49-53, and 55-57 were previously pending. Applicants have amended claims 39, 47, 49, and 55 and added new claims 58 and 59. No claims have been cancelled in this amendment. As such, claims 39-47, 49-53, and 55-59 are pending.

Rejection Under 35 U.S.C. § 101

Claims 55-57 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Patent Office stated “[p]age 24 lines 6-7 of the specification identifies the medium to be a transmission medium/ wireless IP.”¹ Further commenting on this rejection in the “Response to Arguments” section, the Patent Office stated that “*every* reference to the word media or medium in the specification (p. 2, 4, 5, 6, 13, 23) is preceded by ‘transmission’, with transmission media not being statutory.”² However, these references to a “transmission medium” in Applicants’ Specification are entirely irrelevant to the interpretation of the phrase “computer-usable medium” of claims 55-57. Claims 55-57 are not directed to a “transmission medium” as referred to on pp. 2, 4, 5, 6, 13, and 23 of the Specification. Rather, claims 55-57 are directed to a “computer-usable medium.” The Patent Office cannot simply ignore “computer-usable” in the phrase “computer-usable medium” nor is it permissible for the Patent Office to equate the phrase “computer-usable medium” to the phrase “transmission medium” simply because the two phrases share the common term “medium.” The fact of the matter is that Applicants’ Specification does not define “computer-usable medium.” As such, the phrase “computer-usable medium” is to be given its ordinary meaning. According to its ordinary meaning, a “computer-usable medium” is a statutory product.

In the rejection of claims 55-57, the Patent Office also included language stating that nonfunctional-descriptive material recorded on some computer-readable medium is not

¹ Final Office Action mailed April 27, 2009, p. 3.

² *Id.* at p. 8.

statutory.³ The Patent Office never directly states that claims 55-57 are such claims. Applicants submit that claims 55-57 are computer-usable/computer-readable claims having functional limitations, rather than nonfunctional descriptive material. Specifically, claims 55-57 include functional limitations such as maintaining a user profile, maintaining a user listening history, automatically selecting a plurality of broadcast elements, and transmitting the plurality of broadcast elements, all of which are functional elements. The Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility clearly state that “a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory” (citing *In re Lowry*, 32 F.3d 1579, at 1583-84).

Since claims 55-57 are directed to a computer-usable medium that is a statutory product and since claims 55-57 define functional interrelationships between the claimed computer-readable instructions and the processor, claims 55-57 are directed to statutory subject matter. As such, Applicants request that the rejection of claims 55-57 under 35 U.S.C. § 101 be withdrawn.

Rejection Under 35 U.S.C. § 102(e) – Hitson

Claims 39, 41, 43-46, 49, 52, 53, 55, and 57 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0010759 A1 to Hitson et al. (hereinafter “Hitson”). Applicants respectfully traverse. As discussed in MPEP § 2131, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Because the hallmark of anticipation is prior invention, the prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements “arranged as in the claim.” *Net Moneyin, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008) citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983).

³ *Id.* at pp. 2-3.

Applicants have amended claims 39, 49, and 55 to state that the user listening history comprises a list identifying at least a portion of a plurality of broadcast elements previously transmitted to a user device and a time at which each broadcast element of the at least a portion of the plurality of broadcast elements was previously transmitted to the user device. Support for this amendment can be found, for example, at p. 22, lines 7-16 of Applicants' Specification. As such, no new matter has been added.

Regarding claims 39, 49, and 55, Hitson fails to teach at least the claimed feature of maintaining a user listening history comprising a list identifying at least a portion of a plurality of broadcast elements previously transmitted to a user device and a time at which each broadcast element of the at least a portion of the plurality of broadcast elements was previously transmitted to the user device. In the rejection of claims 39, 49, and 55, the Patent Office relied on paragraphs [0139] and [0151] of Hitson and, more specifically, on Hitson's teaching of using a previously transmitted playlist and associated feedback to adjust a user's preferences.⁴ Hitson teaches a system and method for distributing multimedia content in a manner that emulates a television and/or radio broadcast.⁵ Specifically, a playlist is generated for a user based on user preferences of the user. Multimedia content is then delivered to the user according to the playlist. The user may be enabled to provide feedback during playback of the playlist. Paragraph [0139] of Hitson teaches that the feedback may be matched to the playlist. Paragraph [0139] of Hitson also teaches that when generating a new playlist for the user, the feedback matched to the previous playlist of the user may be used to adjust the user preferences (i.e., content genre preferences) of the user such that the adjusted user preferences are used to generate the new playlist for the user. However, even if the previous playlist provided to the user is read as the user listening history of claims 39, 49, and 55, which Applicants do not concede is proper, the previous playlist of Hitson does not include, for each item in the previous playlist, a time at which the item was previously transmitted to a user device of the user. As such, claims 39, 49, and 55 are allowable over Hitson.

Claims 41 and 57 depend from claims 39 and 55, respectively. As such, since claims 39 and 55 are allowable, claims 41 and 57 are also allowable. However, Applicants reserve the right to further address the rejection of claims 41 and 57 in the future, if needed.

⁴ *Id.* at pp. 4 and 8.

⁵ Hitson, Abstract.

Claims 43 and 52 depend from claims 39 and 49, respectively. As such, since claims 39 and 49 are allowable, claims 43 and 52 are also allowable. However, Applicants reserve the right to further address the rejection of claims 43 and 52 in the future, if needed.

Regarding claims 44 and 53, Hitson fails to teach the claimed feature of a personalized broadcast element that includes a reference to a name of the user associated with the user device. In order to reject claims 44 and 53, the Patent Office relied on paragraphs 75, 76, 61, 69, and 70 of Hitson and the username taught in Hitson.⁶ In response to Applicants' previous arguments, the Patent Office stated:

Hitson further teaches users having a My Station on a registered home page (at least paragraph 75-76, 61, 69-70). The claim language interpreted broadly as including 'a reference to a name of the user', such 'reference' being associated with the user's personal home page. Examiner again respectfully points out that Applicant's claim terminology is much broader than the 'jingles' and audio elements saying 'Fred' that Applicant suggests the claim as teaching.⁷

Applicants respectfully disagree with the Patent Office's position. Claims 44 and 53 require a personalized broadcast element that includes a reference to a name of the user associated with the user device. Even if a reference to the user's personal home page (My Station) in Hitson is read as the reference to the name of the user of claims 44 and 53, which Applicants do not concede is proper, Hitson fails to teach that this reference is included within a personalized broadcast element. More specifically, even if the reference to the user's personal home page (My Station) in Hitson is read as the reference to the name of the user of claims 44 and 53, Hitson fails to teach that this reference is included within a content item in the user's playlist (i.e., Hitson fails to teach that this reference is included in a broadcast element). Since Hitson fails to teach each and every feature of claims 44 and 53, claims 44 and 53 are allowable.

Claims 45 and 46 depend from claim 39. As such, since claim 39 is allowable, claims 45 and 46 are also allowable. However, Applicants reserve the right to further address the rejections of claims 45 and 46 in the future, if needed.

Rejection Under 35 U.S.C. § 103(a) – Hitson and Rosenberg

Claims 40, 42, 50, 51, and 56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hitson in view of U.S. Patent No. 7,028,082 B1 to Rosenberg et al.

⁶ Final Office Action mailed April 27, 2009, p. 4.

⁷ *Id.* at p. 9.

(hereinafter “Rosenberg”). Applicants respectfully traverse. Under § 103, “obviousness requires a suggestion of *all limitations in a claim*.” *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (*citing In re Royka*, 490 F.2d 981, 985 (CCPA 1974) (emphasis added)). Thus, in order to reject a claim under § 103, for each limitation of the claim, the Patent Office must show that the limitation is taught or suggested by the cited prior art references or would have otherwise been suggested to one of ordinary skill in the art at the time of the invention.

Before specifically addressing the rejections of claims 40, 42, 50, 51, and 56, it should be noted that Rosenberg has a filing date of March 8, 2001, which is after the filing date of the present application, which is September 7, 2000. Rosenberg claims priority to a provisional application filed on March 8, 2000. Thus, in order to be prior art with respect to the present application, the teachings of Rosenberg relied on by the Patent Office must be supported in the provisional application in compliance with 35 U.S.C. § 112, first paragraph.⁸

Regarding claims 40, 50, and 56, the Patent Office admitted that Hitson fails to teach the subject matter of claims 40, 50, and 56 and therefore relied on column 4, line 63 through column 5, line 3 of Rosenberg.⁹ However, the teachings of column 4, line 63 through column 5, line 3 of Rosenberg are not supported by the provisional application in compliance with 35 U.S.C. § 112, first paragraph. As such, the critical date of Rosenberg with respect to the teachings of column 4, line 63 through column 5, line 3 is March 8, 2001, which is after the September 7, 2000 filing date of the present application. Since Rosenberg is not prior art with respect to the teachings of column 4, line 63 through column 5, line 3, the Patent Office has failed to establish a *prima facie* case of obviousness. As such, claims 40, 50, and 56 are allowable.

Regarding claims 42 and 51, the Patent Office admitted that Hitson fails to teach the subject matter of claims 42 and 51 and therefore relied on column 4, line 63 through column 5, line 3 of Rosenberg.¹⁰ However, the teachings of column 4, line 63 through column 5, line 3 of Rosenberg are not supported by the provisional application in compliance with 35 U.S.C. § 112, first paragraph. As such, the critical date of Rosenberg with respect to the teachings of column 4, line 63 through column 5, line 3 is March 8, 2001, which is after the September 7, 2000 filing date of the present application. Since Rosenberg is not prior art with respect to the teachings of

⁸ See M.P.E.P. § 2136.03(III).

⁹ Final Office Action mailed April 27, 2009, pp. 5 and 7.

¹⁰ *Ibid.*

column 4, line 63 through column 5, line 3, the Patent Office has failed to establish a *prima facie* case of obviousness. As such, claims 42 and 51 are allowable.

With respect to claims 42 and 51, it should also be noted that nothing in Hitson or Rosenberg teaches the claimed features of halting transmission of one of the plurality of broadcast elements to the user device prior to completion of the transmission of the one of the plurality of broadcast elements, and transmitting the alert broadcast element to the user device while the transmission of the one of the plurality of broadcast elements is halted.

Rejection Under 35 U.S.C. § 103(a) – Hitson and Mackintosh

Claim 47 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hitson in view of U.S. Patent No. 6,317,784 B1 to Mackintosh et al. (hereinafter “Mackintosh”). Applicants respectfully traverse. The standards for obviousness are set forth above.

Regarding claim 47, the combination of Hitson and Mackintosh fails to teach or suggest at least the claimed feature of mixing the disc jockey introduction broadcast element with the song broadcast element such that the song broadcast element includes the disc jockey introduction broadcast element. In the rejection of claim 47, the Patent Office admitted that Hitson fails to teach this feature of claim 47, and therefore relied on column 3, lines 1-16 of Mackintosh.¹¹ Mackintosh teaches that radio broadcast materials can be broadcast over the Internet and that the radio broadcast materials may include DJ voice or introduction tracks. However, nothing in Mackintosh teaches that the DJ voice or introduction tracks are mixed with a song track, or song broadcast element. As such, the combination of Hitson and Mackintosh fails to teach the claimed feature of mixing the disc jockey introduction broadcast element with the song broadcast element such that the song broadcast element includes the disc jockey introduction broadcast element. Since the combination of Hitson and Mackintosh fails to teach or suggest all of the features of claim 47 and the Patent Office has failed to show that the features of claim 47 that are not taught or suggested by the combination of Hitson and Mackintosh would have otherwise been suggested to one of ordinary skill in the art at the time of the invention, claim 47 is allowable.

¹¹ *Id.* at p. 7.

New Claims 58 and 59

Applicants have added new claims 58 and 59, which depend from claims 43 and 52, respectively. The subject matter of claims 58 and 59 can be found at, for example, page 15, lines 2-22 of Applicants' Specification. As such, no new matter has been added.

Since claims 58 and 59 depend from claims 43 and 52, respectively, and claims 43 and 52 were rejected by the Patent Office as being anticipated by Hitson, Applicants will address claims 58 and 59 with respect to Hitson. Hitson fails to teach the claimed features of wherein the user profile includes information indicating a preference of a frequency of selection and transmission of a plurality of types of broadcast elements (claims 43 and 52) and the plurality of types of broadcast elements comprise at least two types of broadcast elements selected from a group consisting of: songs, introductions, news, traffic, weather, sports scores and game reports, stock prices and news, jingles and station identification, advertisements, school closings, reminders, instructions, time, date, talk/morning show, and serialized radio programs (claims 58 and 59). As such, claims 58 and 59 are allowable over Hitson.

Conclusion

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicants' representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

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